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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,512	11/13/2000	Yoshihisa Usami	Q60499	4483

7590 10/02/2002  
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EXAMINER
VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
1732	2

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/709,512

Applicant(s)

USAMI

Examiner

M. VARGOT

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) 1 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-10 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

- ☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1732

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to an information recording medium, classified in class 428, subclass 64.1.
  - II. Claims 2-10, drawn to a method of manufacturing an information recording medium, classified in class 264, subclass 1.33.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by methods other than injection molding--for instance, the substrate can be made by photopolymerization or compression molding and the dye recording layer disposed thereon.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Mexic on February 22, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 2-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1 has been

Art Unit: 1732

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The description of "alternately arranging" is extremely vague in the instant specification and it is not at all clear exactly what applicant intended by this language. Does applicant mean that the disks are arranged on the same cooling line? Clarification is required without the insertion of any new matter.

3. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the language "alternately arranging" is vague and indefinite as such would encompass any number of arrangements and procedures. By "alternately arranging" does applicant mean arranging disks first from one mold cavity and then from the other cavity? Perhaps applicant means that the disks are taken from each cavity (ie, alternately) and then arranged in/on the same cooling line. Clarification is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1732

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth at page 1 and page 2, line 17 through page 3 of the instant specification.

Applicant admits that it is known in the art to mold two substrates in one injection molding cycle, remove them from the mold and cool them. See page 2, lines 17-19 and page 1 concerning the deposition of a dye recording layer. Essentially, then, the prior art fails to teach specifically a step of "alternately arranging" as set forth in instant claim 2, which, as best understood from the instant specification, appears to be no more than removing the disks one at a time and placing them one at a time within the same cooling device. It certainly would have been obvious to one of ordinary skill in the art to remove injection molded disks one at a time and arrange them thusly for cooling within the same device dependent on mold take-out apparatus available and to maintain a consistent heat history for the disks and hence instant claim 2 is submitted as being obvious over the admitted prior art. As it is known to apply a recording layer of organic dye on the substrates, a dye solution coating machine would clearly have been required in the prior art. The exact number of such machines being employed per injection molding apparatus would have been within the skill level of the art dependent on cycle time required for the coating. Hence, instant claim 3 is obvious over the prior art. Page 2, lines 19-23 of the instant specification renders instant claims 4-6 as obvious, since it is admittedly known to support the substrates vertically in a magazine or place them flatwise on a rotary table. The magazine of the admitted prior art would have rendered the instant screw mechanism and rotatable cylinder as obvious

Art Unit: 1732

thereover in that the latter constitute known magazine type conveyor means by which thin, circular objects would be cooled.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in the instant specification at pages 1-3 in view of Motokawa et al (see col. 1, lines 49-53).

The admitted prior art teaches that the instant invention is known except for the aspect of employing two disks which were injection molded in the same cycle to make the laminate--ie, the prior art allegedly takes the second disk to be bonded from a previously molded stack. However, the admitted prior art of Motokawa et al teaches laminating two disks together which were (simultaneously) produced in one molding machine using two stampers. Although Motokawa et al teaches that such is not really advantageous from a moisture content standpoint, the fact that it has been done is evidence enough for obviousness, which only requires a reasonable expectation of success. It would have been obvious to one of ordinary skill in the art to modify the admitted prior art as taught in the admitted prior art of Motokawa et al to reduce cycle time in forming the laminate.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Slater et al discloses a cooling carousel for optical disks and Hayashi et al a cooling device for injection molded articles. Satoh (see Example 12 and Fig. 4B) shows the instant laminated disk. Kanome also teaches laminated disks.

Art Unit: 1732

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

September 29, 2002

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

*9/29/02*